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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,319	06/11/2001	William T. Donofrio	2640/1G819US1	5187
7278	7590	03/08/2004		
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			EXAMINER NGUYEN, VI X	
			ART UNIT 3731	PAPER NUMBER 16
DATE MAILED: 03/08/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,319

Applicant(s)

DONOFRIO ET AL.

Examiner

Victor X Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 27, 28, 30-40, 57, 58 and 66-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 27, 28, 30-40, 57, 58 and 66-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 14.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on 1/30/2004 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/879,319 is acceptable and a CPA has been established. An action on the CPA follows.

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on 1/30/2004 have been considered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 27, 28, 30-40, 57-58 and 66-68 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Thomas (5,026,387) in view of Buss et al (6,037,724).

Regarding claims 1,3-4,31,33,66-68, Thomas discloses a system for implementing surgical procedures including: an ultrasonic surgical handpiece (2) has an end-effector (3), a generator (1) controls the handpiece, wherein an electrical connection (fig. 1) connects the handpiece and the generator. The generator (1) sends a drive current to drive the handpiece (2) which imparts longitudinal movement to the end-effector (3); and wherein a finger-operated switch (6a) provides on a housing of the handpiece (2), the switch activates the handpiece at a first power level. However, Thomas does not disclose a switch that has a sensor monitored

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pressure value which reaches a high threshold and deactivates the hand piece if the sensor monitor pressure value reaches a low threshold.

Buss et al teach "a sensor-activated" switch (Figs 1, 10 and col. 4, lines 44-67, col. 5, lines 48-65).

It would have been obvious to one having ordinary skill in the art at the same time the invention was made to modify Thomas by adding a "sensor-activated" switch as taught by Buss et al in order to provide sufficient sensor activated switch which makes the device more ergonomic design, less tiring for the user. Furthermore, it is noted that such a "sensor-activated" switch is merely a common switch activated by the pressure of a user's finger and deactivated by the release of the user finger.

Regarding claims 2,5,32,34 and 40, Thomas discloses the switch (6a) is distally located on the handpiece (2). The handpiece is operated at a power level, wherein the pressure is monitored by a sensor located inside the handpiece (2) which selected from a group consisting of an electro-mechanical switch, a sensitive resistor (col. 5, lines 61-67 and col. 6, lines 1-3); and wherein the switch includes a pair of switch button members (6a).

Regarding claims 6-8 and 35-37, Thomas discloses the switch (6a) has a region for resting of a finger (fig. 1); and wherein the switch (6a) is aligned and indexed to the end-effector (3).

Regarding claims 9-10 and 38-39 Thomas fails to disclose a first and a second post are extending outwardly away from the surface; and wherein a first raised section and a second raised section on the upper surface of the switch, said raised section is supported by a recessed section formed there between. It would have been obvious to one having ordinary skill in the art at the same time the invention was made to construct the Thomas' device with a first and a second post are

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extending outwardly away from the surface; and wherein a first raised section and a second raised section on the upper surface of the switch, said raised section is supported by a recessed section thereof, since it has been held to be within the general skill of worker in the art to make plural parts unitary as a matter of obvious engineering choice. In re Larson, 144 USPQ 347 (CCPA 1965); In re Lockart, 90 USPQ 214 (CCPA 1951).

Regarding claims 27-28,30 and 57-58, Thomas discloses the switch (6a) has an inadvertent activation. The switch is a hysteresis switch (6a); and wherein the switch provides its switching functionality according to a lagging effect.

Response to Amendment

4. Applicant's arguments with respect to claims 1, 31 and 66 have been considered but are moot in view of the new ground(s) of rejection. Applicant is asked to please refer to the modified prior art rejection above wherein examiner addresses applicant's concerns regarding prior art rejections. For example, Thomas discloses a system for implementing surgical procedures including: an ultrasonic surgical handpiece (2) has an end-effector (3), a generator (1) controls the handpiece, wherein an electrical connection (fig. 1) connects the handpiece and the generator. The generator (1) sends a drive current to drive the handpiece (2) which imparts longitudinal movement to the end-effector (3); and wherein a finger-operated switch (6a) provides on a housing of the handpiece (2), the switch activates the handpiece at a first power level. However, Thomas does not disclose a switch that has a sensor monitored pressure value which reaches a high threshold and deactivates the hand piece if the sensor monitor pressure value reaches a low threshold.

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen
Examiner
Art Unit 3731

Vn *VN*
March 2, 2004


MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
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